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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,275	03/11/2005	Pedro, Harold, Han Hermkens	O-2002.724 US	1568

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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03/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/510,275	Applicant(s) HERMKENS ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-14 and 16 are pending in the application.

This action is in response to applicants' amendment dated December 11, 2008.

Claims 1, 4, 6, 7, 10, 11 and 16 have been amended.

Response to Arguments

Applicant's arguments filed December 11, 2008 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 2) in the last office action, which is hereby **withdrawn**.
2. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 3) in the last office action, which are hereby **withdrawn**.
3. With regards to the 35 U.S.C. § 103, obviousness rejection as being unpatentable over van der Burg et al., U.S. Patent No. 4,016,161 and 4,054,572, the applicants amendments and remarks have been fully considered but they are not found persuasive. The applicants stated that the Examiner has not identified a reason that would have led a chemist to select and modify a known compound in the van der Burg patents to arrive at the compound recited in claim 1 and that the van der Burg generic compound of formula I does not encompass the presently claimed compounds. However, the generic structure of van der Burg indicates that the $-(CH_2)_nNR_5R_6$ is

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attached to the piperidine ring in variable positions with the positions being labeled 1, 2, 3 and 4. It is noted that van der Burg specifically teaches compounds attached to the piperidine ring in the 2 and 3 position but as stated in the MPEP 2144.09 states “Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) ... are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

The first point can be addressed by citing *In re Deuel* 34 USPQ2d 1210, 1214, which states, “Structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties.” This is clearly all the motivation necessary to render a species obvious. Thus as stated in the previous office action one of ordinary skill in the art would have been motivated to select 1-diethylamine from the generic teaching of van der Burg to prepare the compounds of the instant invention.

Claims 1-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over van der Burg et al., U.S. Patent No. 4,016,161 and 4,054,572, for reasons of record and stated above.

4. With regards to the provisional obviousness-type double patenting rejection as being unpatentable over claims 1-16 and 21 of copending Application No. 11/861,427 of

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the last office action, the applicants requested that this rejection be held in abeyance at this time.

Claims 1-14 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 21 of copending Application No. 11/861,427, for reasons of record and stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. With regards to the provisional obviousness-type double patenting rejection as being unpatentable over claims 1-14 of copending Application No. 12/115,983 of the last office action, the applicants requested that this rejection be held in abeyance at this time.

Claims 1-14 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 12/115,983, for reasons of record and stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In view of the amendment dated December 11, 2008, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by R1-R5 and R9-R10 in the provisos labeled (i), (ii) and (iii) at the end of claim 1 which fails to set forth the meets and bounds of the range.
- b. Claims 4 and 11 are vague and indefinite in that it is not further limiting of claim 1.
- c. Claim 11 is vague and indefinite in that it is a duplicate of claim 4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624